

From the INTERNATIONAL SEARCHING AUTHORITY

PCT

INVITATION TO PAY ADDITIONAL FEES

(PCT Article 17(3)(a) and Rule 40.1)

To:

LUCAS & CO
Attn. Lucas, Phillip Brian
135 Westhall Road
Warlingham
Surrey CR6 9HJ
UNITED KINGDOM

REGISTERED MAIL

Date of mailing
(day/month/year)

02/12/2004

Applicant's or agent's file reference

DQ, 016 - PCT

PAYMENT DUE

within 45 ~~days~~ days
from the above date of mailing

International application No.

PCT/GB2004/050001

International filing date
(day/month/year)

16/08/2004

Applicant

VARCO I/P, INC.

1. This International Searching Authority

- (i) considers that there are 2 (number of) inventions claimed in the international application covered by the claims indicated ~~below~~ on the extra sheet:

and it considers that the international application does not comply with the requirements of unity of invention (Rules 13.1, 13.2 and 13.3) for the reasons indicated ~~below~~ on the extra sheet:

- (ii) ☒ has carried out a partial international search (see Annex) ☐ will establish the international search report on those parts of the international application which relate to the invention first mentioned in claims Nos.:

see annex

- (iii) will establish the international search report on the other parts of the international application only if, and to the extent to which, additional fees are paid

2. The applicant is hereby **invited**, within the time limit indicated above, to pay the amount indicated below:

EUR 1.550,00 x 1 = EUR 1.550,00
Fee per additional invention number of additional inventions total amount of additional fees

Or, _____ x _____ = _____

The applicant is informed that, according to Rule 40.2(c), the payment of any additional fee may be made under protest, i.e., a reasoned statement to the effect that the international application complies with the requirement of unity of invention or that the amount of the required additional fee is excessive.

3. ☐ Claim(s) Nos. _____ have been found to be unsearchable under Article 17(2)(b) because of defects under Article 17(2)(a) and therefore have not been included with any invention.

Name and mailing address of the International Searching Authority



European Patent Office, P.B. 5818 Patentlaan 2
NL-2280 HV Rijswijk
Tel. (+31-70) 340-2040, Tx. 31 651 epo nl,
Fax: (+31-70) 340-3016

Authorized officer

Chrystalla Louca-Dreher

This International Searching Authority found multiple (groups of) inventions in this international application, as follows:

1. claims: 1-28, 32-37

Apparatus and method for handling pipes.

2. claims: 29-31

A method for indicating slips of an elevator have engaged a pipe.

The ISA has carried out a partial search which relates to the invention I mentioned above. The applicant is invited to pay an additional search fee for invention II, as listed above.

The reasons for which the present application has been deemed to contain two inventions which are not linked such that they form a single general inventive concept, as required by Rules 13.1, 13.2 and 13.3 PCT are as follows:

The prior art has been identified as being D1: US-A-2002/121160 which discloses a method and apparatus for handling pipes.

Invention I: From a comparison of the disclosure of this prior art and the technical features of independent claim 1 (which is the first independent claim relating to invention I), the features which are known from D1 (see pages 4 and 5 in particular), are the following:

- a body having a tapered surface and at least a first slip and a second slip slidable on the tapered surface,
- a slip actuator for setting said at least first slip and said second slip

so that the technical feature of claim 1 that can be seen to make a contribution over this prior art (Special Technical Features (STF), Rule 13.2 PCT) is:

- the first slip and the second slip have interengaging elements therebetween such that upon actuation of said slip actuator, said first slip is set and said second slip is set by the interengaging elements transferring the setting force from the slip actuator through said first slip to said second slip.

From this STF the objective problem to be solved by the first invention can be construed as:

providing a slip mechanism whereby the at least two slips are configured with an interengaging member which allows the slips to part from each other. These elements allows the transfer of force from the actuator to the slips therefore setting the slips simultaneously and unsetting the slips evenly, thereby reducing the damage to the pipe member and

BEST AVAILABLE COPY

increasing the grip on the pipe.

Invention II: From a comparison of the disclosure of this prior art and the technical features of independent claim 29, the features of said claim that can be seen to make a contribution over this prior art (STF) are:

- a piston passing a signal port upon which pressurised hydraulic fluid communicates with hydraulic fluid in a line connected to the signal port which indicates to the controller that the slips are actuated.

From this, the objective problem to be solved can be construed as providing a method whereby the actuation of the slips is indicated to the operator.

The above analysis shows that the special technical features of invention I (claim 1) are neither the same as nor corresponding to those of invention II (claim 29).

Also, examining the possible correspondence by technical effect, one finds the technical effect of the first invention to be the use of interengaging elements to set a slip apparatus and that the technical effect of the second invention to be the use of a hydraulic line to alert the operator that the slips have been set.

This appears to show lack of corresponding technical effect as well. Consequently, neither the objective problem underlying the subjects of the two claimed inventions, nor their solutions as defined by the special technical features allow for a relationship to be established between the said inventions, which involves a single general inventive concept.

In conclusion therefore, the two groups of claims are not linked by common or corresponding special technical features and define two different inventions not linked by a single general inventive concept. The application does not meet the requirements of Unity of Invention as required in Rule 13(1) and (2) PCT.

No search has been carried out for claims 29 to 31.

The application relates to a plurality of inventions, or groups of inventions, in the sense of Rule 13.1 PCT. They have been divided as defined above. If the applicant pays additional fees for the one not yet searched group of inventions, then the further search may reveal further prior art that gives evidence of a further lack of unity 'a posteriori' within the one of the not yet searched group. In such a case only the first invention in this group of inventions, which is considered to lack unity of invention, will be the subject of a search. No further invitation to pay further additional fees will be issued. This is because Article 17(3)(a) PCT stipulates that the ISA shall establish the International Search Report on those parts of the international application which relate to the invention first mentioned in the claims ('main invention') and for those parts which relate to inventions in respect of which the additional fees were paid. Neither the PCT nor the PCT guidelines provide a legal basis for further invitations to pay further additional search fees (W17/00, point 11 and W1/97, points

11-16).

BEST AVAILABLE COPY

1. The present communication is an Annex to the invitation to pay additional fees (Form PCT/ISA/206). It shows the results of the international search established on the parts of the international application which relate to the invention first mentioned in claims Nos.:

see 'Invitation to pay additional fees'
2. This communication is not the international search report which will be established according to Article 18 and Rule 43.

3. If the applicant does not pay any additional search fees, the information appearing in this communication will be considered as the result of the international search and will be included as such in the international search report.

4. If the applicant pays additional fees, the international search report will contain both the information appearing in this communication and the results of the international search on other parts of the international application for which such fees will have been paid.

C. DOCUMENTS CONSIDERED TO BE RELEVANT

Category *	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
A	US 6 684 737 B1 (PIETRAS BERND-GEORG ET AL) 3 February 2004 (2004-02-03) column 4, line 16 - column 6, line 16; figures 1,2	1,20
A	US 2002/121160 A1 (BANGERT DANIEL S) 5 September 2002 (2002-09-05) page 4, paragraph 46 - page 4, paragraph 47; figure 7	1,20
A	US 6 227 587 B1 (TERRAL BEN D) 8 May 2001 (2001-05-08) column 7, line 65 - column 8, line 21; figures 1-3	1,20
A	US 5 992 801 A (TORRES CARLOS A) 30 November 1999 (1999-11-30) column 4, line 61 - column 5, line 56; figure 3	1,20
A	US 4 415 193 A (CARLBERG CHARLES E) 15 November 1983 (1983-11-15) abstract	1,20
A	US 6 279 662 B1 (SONNIER ERROL A) 28 August 2001 (2001-08-28) abstract	1,20

☒ Further documents are listed in the continuation of box C.

☒ Patent family members are listed in annex.

* Special categories of cited documents:

A document defining the general state of the art which is not considered to be of particular relevance

E earlier document but published on or after the international filing date

L document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)

O document referring to an oral disclosure, use, exhibition or other means

P document published prior to the international filing date but later than the priority date claimed

T later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention

X document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone

Y document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art.

G document member of the same patent family

C.(Continuation) DOCUMENTS CONSIDERED TO BE RELEVANT		
Category °	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
A	US 6 305 649 B1 (EMMETT ROBERT ET AL) 23 October 2001 (2001-10-23) abstract	1,20
X	US 6 536 520 B1 (SNIDER RANDY GENE ET AL) 25 March 2003 (2003-03-25) cited in the application the whole document	32-37

BEST AVAILABLE COPY

Patent document cited in search report		Publication date	Patent family member(s)	Publication date
US 6684737	B1	03-02-2004	GB 2346576 A	16-08-2000
			AU 1989000 A	18-08-2000
			CA 2359214 A1	03-08-2000
			EP 1147285 A1	24-10-2001
			WO 0045027 A1	03-08-2000
			NO 20013582 A	04-09-2001
US 2002121160	A1	05-09-2002	US 6378399 B1	30-04-2002
			US 2004055421 A1	25-03-2004
			CA 2266367 A1	19-03-1998
			DE 69726196 D1	18-12-2003
			EP 1015184 A1	05-07-2000
US 6227587	B1	08-05-2001	NONE	
US 5992801	A	30-11-1999	NONE	
US 4415193	A	15-11-1983	CA 1164442 A1	27-03-1984
US 6279662	B1	28-08-2001	WO 9948794 A1	30-09-1999
US 6305649	B1	23-10-2001	AU 757426 B2	20-02-2003
			AU 3321399 A	08-06-2000
			BR 9901780 A	11-07-2000
			GB 2338008 A ,B	08-12-1999
			NO 992660 A	06-12-1999
US 6536520	B1	25-03-2003	AU 4858501 A	30-10-2001
			CA 2404752 A1	25-10-2001
			EP 1274919 A1	15-01-2003
			WO 0179652 A1	25-10-2001
			NO 20024756 A	27-11-2002
			US 2003164276 A1	04-09-2003
			US 2003173073 A1	18-09-2003
			US 2004144547 A1	29-07-2004

BEST AVAILABLE COPY